

REMARKS

Reconsideration of this application is requested in view of the amendments to the claims and the remarks presented herein.

The claims in the application are claims 1 to 20, non-elected claim 21 has been cancelled but Applicants reserve the right to file a divisional application directed thereto. Claim 6, which was indicated by the Examiner as being drawn to allowable subject matter, has been rewritten in independent form and is therefore, deemed to be allowable. It is assumed that the non-elected claims 15 to 20 will be rejoined with the product claims 1 to 14 when they are found allowable in accordance with the Commissioner's official notice dated February 28, 1996, a copy of which is enclosed herewith for the Examiner's convenience.

The obviousness type double patenting rejection based upon U.S. patent application Serial No. 10/398,095 is obviated by the Terminal Disclaimer filed herewith.

Claim 1 to 5 and 7 to 10 were rejected under 35 USC 102 as being anticipated by Satomi et al patent. The Examiner states that Satomi et al discloses a composition comprising at least one carboxylic ester as claimed and the Examiner deems that he has a reasonable basis for deeming that the water insoluble polymer feature is inherent therein.

Applicants respectfully traverse this ground of rejection since the Satomi et al patent does not anticipate or render obvious Applicants' invention which is directed to a water-insoluble polymer containing 0.1 to 30% by weight of at least one carboxylic acid ester whose alcohol component is a polyhydroxy compound and the polymer is stabilized with protective colloids. In contrast thereto, the Satomi et al patent relates to an aqueous suspension of a solid organic peroxide containing a protective colloid, a surface active agent and water to form an aqueous emulsion. There is no dispersion powder and Applicants do not have an aqueous suspension. Moreover, Applicants' compositions do not contain a solid organic peroxide and this is clearly excluded by the present claims which use the term "consisting essentially of" which would exclude ingredients that would change the nature of the composition. Lines 40 to 56 of column 6 discusses the protective colloids and the surface active agents. The same is true for Example 1. Therefore, the reference neither anticipates nor renders obvious Applicants' invention and withdrawal of this ground of rejection is requested.

Claim 1 to 3, 5, 8 to 10, 15 to 18, 21 and 22 were rejected under 35 USC 102 as being anticipated by or under 35 USC 103 as being obvious over the Chiou et al patent. The Examiner states that the Chiou et al patent discloses a spray dried emulsion polymer comprising a polymer powder for cement applications and discloses that the composition contains a carboxylic ester in lines 52 to 67 of column 1 and contains all of the limitations of Applicants' claims.

Applicants respectfully traverse this ground of rejection since the Chiou et al patent does not relate to Applicants' invention and does not mention the presence of a protective colloid. The reference claims a method of providing an emulsion comprising at least one emulsion polymer and at least one surfactant having an HLB below 7 and then spray drying the emulsion. The surfactant could be a glycerol ester or a poly glycerol ester but there is no water insoluble polymer in the composition nor is there a protective colloid therein. The emulsion polymers are indicated as being core-shell emulsion polymers are not of a water insoluble type form. In fact, Chiou et al teaches in lines 26 to 33 of column 1 to avoid a protective colloid such as polyvinylalcohol. Therefore, the Chiou et al patent does not anticipate or render obvious Applicants' invention and withdrawal of this ground of rejection is requested.

In view of the amendments to the claims and the above remarks, it is believed that the claims clearly point out Applicants' patentable contribution and favorable reconsideration of the application is requested.

Respectfully submitted,
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CAM:ds
Enclosures

OFFICIAL GAZETTE NOTICE

Guidance on Treatment of Product and Process Claims in light of In re Ochiai, In re Brouwer and 35 U.S.C. § 103(b)

The purpose of this Notice is to provide guidance to Patent and Trademark Office personnel and to the public on the proper consideration of certain claims in light of In re Ochiai, **F.3d **, 37 USPQ2d 1127 (Fed. Cir. 1995) and In re Brouwer, **F.3d **, ** USPQ2d **** (Fed. Cir. 1995) and the passage of 35 U.S.C. § 103(b), which became effective November 1, 1995. Ochiai, Brouwer and § 103(b) relate to how process claims directed to making or using nonobvious products are to be treated.

The Court in Ochiai and Brouwer addressed the issue of whether an otherwise conventional process could be patented if it were limited to making or using a nonobvious product. In both cases, the Federal Circuit held that the use of *per se* rules is improper in applying the test for obviousness under the 35 U.S.C. § 103. Rather, § 103 requires a highly fact-dependent analysis involving taking the claimed subject matter as a whole and comparing it to the prior art. To support a rejection under § 103, the collective teachings of the prior art must have suggested to one of ordinary skill in the art that, at the time the invention was made, applicant's claimed invention would have been obvious. In applying this test to the claims on appeal, the Court held that there simply was no suggestion or motivation in the prior art to make or use the nonobvious products to which the claims were limited and consequently overturned the rejections based upon § 103.

Interpreting a claimed invention as a whole requires consideration of all claim limitations. Thus, language in a process claim which recites making or using a nonobvious product must be treated as a material limitation, and a motivation to make or use the nonobvious product must be present in the prior art for a § 103 rejection to be sustained.

In light of Ochiai and Brouwer, Office personnel will consider all claim limitations when analyzing process claims which make or use nonobvious products under § 103. Office personnel will focus on treating claims as a whole and follow the analysis set forth in Graham v. John Deere, 383 U.S. 1, 148 USPQ 459 (1966).

Accordingly, to facilitate examination under § 103, where product and process claims are presented in the same application, applicant may be called upon under 35 U.S.C. § 121 to elect claims to either the product or process. The claims to the non-elected invention will be withdrawn from further consideration. However, in the case of an elected product claim, rejoinder will be permitted when a product claim is found allowable and the withdrawn process claim depends from or otherwise includes all the limitations of an allowed product claim. Withdrawn process claims not commensurate in scope with an allowed product claim will not be rejoined. In the event of rejoinder, the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104 - 1.106. If the application containing the rejoined claims is not in condition for allowance, the subsequent Office action may be made final, or, if the application was already under final rejection, the next Office action may be an advisory action.

35 U.S.C. § 103(b) is applicable to biotechnological processes only. Section 103(b) precludes a rejection of process claims which involve the use or making of certain nonobvious biotechnological compositions of matter under § 103(a). Section 103(b) requires that

1. the biotechnological process and composition of matter be contained in either the same application or in separate applications having the same effective filing date;
2. both the biotechnological process and composition of matter be owned or subject to an assignment to the same person at the time the process was invented;
3. a patent issued on the process also contain the claims to the composition of matter used in or made by the process, or, if the process and composition of matter are in different patents, the patents expire on the same date;
4. the biotechnological process falls within the definition set forth in § 103(b); and
5. a timely election be made to proceed under the provisions of § 103(b).

In view of the Federal Circuit's decisions in Ochiai and Brouwer, an applicant's need to rely upon § 103(b) should be rare. Consequently, the Patent and Trademark Office will treat § 103(b) elections on a case-by-case basis by way of petition under 37 CFR 1.182. That petition must establish that all the requirements set forth in § 103(b) have been satisfied. An election will normally be considered timely if it is made no later than the earlier of either (1) the payment of the issue fee, or (2) the filing of an appeal brief in an application which contains a composition of matter claim which has not been rejected under 35 U.S.C. §§ 102 or 103.

In an application where at least one composition of matter claim has not been rejected under 35 U.S.C. §§ 102 or 103, a § 103(b) election may be made by submitting the petition and an amendment requesting entry of process claims which correspond to the composition of matter claim.

For applications pending on or after November 1, 1995, in which the issue fee has been paid prior to the date of this Notice, the timeliness requirement for an election under § 103(b) will be considered satisfied if the conditions of 37 CFR 1.312(b) are met. However, if a patent is granted on an application entitled to the benefit of § 103(b) without an election having been made as a result of error without deceptive intent, patentees may file a reissue application to permit consideration of process claims which qualify for § 103(b) treatment.

Any questions, comments or suggestions regarding petitions under 37 CFR 1.182 filed pursuant to this Notice should be directed to the Special Program Law Office, attention: Hiram Bernstein, Senior Legal Advisor. All other questions, comments or suggestions regarding this Notice should be directed to the Solicitor's Office, attention: Craig Kaufman, Associate Solicitor.

Date: FEb 28 1996



Bruce A. Lehman
Assistant Secretary of Commerce and
Commissioner of Patents and Trademarks